**Application No.: 10/637,663** 

## **REMARKS**

## I. Introduction

In response to the Office Action dated December 14, 2005, Applicants have amended claims 1, 8, and 12 to more particularly point out and distinctly claim the subject matter of the invention. No new matter has been added. In view of the foregoing amendments and the following remarks, Applicants respectfully submit that all pending claims are in condition for allowance.

## II. Claim Rejections Under 35 U.S.C. § 112

Claims 1 – 7 stand rejected under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter of the invention. More particularly, the Examiner asserts that the limitation "the application environment" recited in claims 1 lacks sufficient antecedent basis. Claim 1 has been amended to remove this recitation. Accordingly, withdrawal of this rejection is respectfully requested.

## III. Claim Rejections Under 35 U.S.C. § 102

Claims 1 – 13 stand rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by U.S. Patent Application No. 2001/0054166 to Fukuda. Applicants traverse this rejection for at least the following reasons.

Claim 1 recites, among other things, an assembly for an LSI test comprising a peripheral circuit coupled to a target LSI and allowing the target LSI to operate as in actual operation, a socket into which the target LSI is inserted, and a printed circuit board on which the peripheral circuit and the socket are mounted. Independent claims 8 and 12 recite similar features. At least these features are not disclosed by Fukuda.

Fukuda appears to disclose an LSI having a built-in self test (BIST) circuit. The LSI starts the self test for a logic circuit included in the LSI by a signal from an IC tester located

**Application No.: 10/637,663** 

outside the LSI. The logic circuit transmits test result data to the BIST. The BIST then transmits the compressed test result data.

According to an exemplary embodiment of the present invention, an assembly for performing a functional test on an LSI in actual operation is provided. The LSI to be tested is inserted in a socket mounted on a printed circuit board on which a peripheral circuit is also mounted. A test signal output from an LSI tester outside the printed circuit board is supplied and stored in the peripheral circuit. The LSI receives the stored signal and processes the test signal while inputting/outputting data to/from the peripheral circuit. The LSI outputs the result signal to the LSI tester. The Examiner alleges that the printed circuit board recited in the claims corresponds to one of the IC tester, PLL circuit, or BIST disclosed by Fukuda. However, in Fukuda, the test is completed in the LSI without being mounted on a test board, such as the printed circuit board recited in the claims. Therefore, Fukuda does not disclose each and every feature recited in the claims.

Thus, as anticipation under 35 U.S.C. § 102 requires that each element of the claim in issue be found, either expressly described or under principles of inherency, in a single prior art reference, *Kalman v. Kimberly-Clark Corp.*, 713 F.2d 760, 218 USPQ 781 (Fed. Cir. 1983), and at a minimum, Fukuda fails to disclose the features described above, it is clear that Fukuda does not anticipate claim 1 or any claims dependent thereon.

Claim 13 recites, among other things, an LSI test method comprising the step of operating a non-defective LSI which is configured as a target LSI to be tested and has been confirmed to operate normally, in a circuit equivalent to a circuit actually used, and generating and storing a test signal and a reference test signal result based on a signal supplied to the non-defective LSI and a signal output from the non-defective LSI, respectively. At least this feature is not disclosed by Fukuda.

**Application No.: 10/637,663** 

The Examiner equates the test enable signal 108 disclosed by Fukuda with the recited

reference test result signal. However, Fukuda does not disclose how this test enable signal is

generated or stored. Accordingly, Fukuda fails to disclose every feature of claim 13. Thus,

Fukuda also fails to anticipate claim 13.

IV. Conclusion

Having fully responded to all matters raised in the Office Action, Applicants submit that

all claims are in condition for allowance, an indication for which is respectfully solicited.

If there are any outstanding issues that might be resolved by an interview or an

Examiner's amendment, the Examiner is requested to call Applicants' attorney at the telephone

number shown below.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is

hereby made. Please charge any shortage in fees due in connection with the filing of this paper,

including extension of time fees, to Deposit Account 500417 and please credit any excess fees to

such deposit account.

Respectfully submitted,

McDERMOTT WILL & EMERY LLP

Michael E. Foxarty

Registration No. 36,139

Please recognize our Customer No. 20277

as our correspondence address.

600 13<sup>th</sup> Street, N.W.

Washington, DC 20005-3096

Phone: 202.756.8000 MEF:dab

Facsimile: 202.756.8087

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7